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USSN 10/555,857  
Docket No.: SGK-028

## REMARKS

Presently, Claim 51 is amended to incorporate limitations of Claim 59 and Claim 59 is cancelled. Claims 1-50, 52, 58, and 61-66 were previously cancelled. Accordingly, Claims 51, 53-57, 60, and 67 are pending in this application.

**Claim Rejections Under 35 U.S.C. § 102(b) Over Plehiers**

Claims 51, 55, and 59 are rejected under 35 U.S.C. § 102(b) as anticipated by PCT publication WO 02/094838 ("Plehiers").

With respect to Claim 51, the Examiner stated that "Plehiers et al. teach hydrolysable paint compositions (page 1, lines 12-20) comprising a compound that is an organosilyl ester of a carboxylic acid wherein the carboxylic acid part of the ester is saturated at the alpha carbon" and that "[s]everal components in Plehiers et al. can be considered co-binders such as the other monomers and comonomers in the binders (page 8, lines 9-18)." Office Action at 2.

Applicants respectfully traverse this rejection. The organosilyl ester saturated at the alpha carbon disclosed in Plehiers is not a component of a hydrolysable paint composition as required in Claim 51. Rather, the organosilyl ester in Plehiers is an intermediate used in preparation of an unsaturated silyl ester which in turn is used as a monomer or a comonomer in the production of a hydrolysable paint composition. There does not appear to be any disclosure in Plehiers that residual amounts of the saturated organosilyl ester are present in the final paint composition. Nor does there appear to be any reference in Plehiers to combining this saturated organosilyl ester with the co-binders.

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Accordingly, for all of the above reasons, Applicants respectfully request withdrawal of the anticipation rejection of Claim 51 over Plehiers.

Claim 55 depends on Claim 51 and Applicants respectfully present that the anticipation rejection of Claim 55 over Plehiers does not apply for the same reasons as those discussed above with respect to Claim 51. Additionally, Claim 59 is cancelled and, therefore, the anticipation rejection of Claim 59 over Plehiers is moot.

**Claim Rejections Under 35 U.S.C. § 102(b) Over Slater**

Claims 51 and 54 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,331,074 ("Slater").

With respect to Claim 51, the Examiner stated, *inter alia*, that "Slater et al. teach compositions comprising a compound that is an organosilyl ester of a carboxylic acid wherein the carboxylic acid part of the ester is saturated at the alpha carbon (column 6, lines 46-68)." Office Action at 2-3.

Applicants respectfully traverse this rejection. Applicants respectfully present that the composition of Claim 51 is hydrolysable while the coating of Slater is not hydrolysable. The effectiveness of the Slater composition lies in providing a non-stick or low energy surface. Slater describes the silicon rubber compositions of Slater as being advantageous over "conventional antifouling compositions containing marine biocides which are gradually leached from the paint" while "[t]he silicone rubber coatings rely on their low surface energy, rather than on biocides, to inhibit settlement of marine organisms." Slater at col. 1, lines 16-28. The "conventional antifouling compositions" described by Slater include hydrolysable paint

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compositions which are rendered hydrolysable so that the biocide is leached out. Therefore, Slater does not relate to hydrolysable paint compositions.

Furthermore, the amended Claim 51 recites an antifoulant. In contrast, Slater does not disclose paint compositions with an antifoulant. Since the "conventional antifouling compositions" described by Slater include hydrolysable paint compositions which are rendered hydrolysable so that the biocide is leached out, the use of an antifoulant would be contrary to the purpose of the disclosure in Slater.

Slater also states that the hydrolysable groups should not be used in excess. *Id.* at col. 1, lines 56-63. This means that the hydrolysable groups are no longer present in the cured coating composition because they have already been utilized in cross-linking the hydroxy functional polydiorganosiloxanes to produce the cross-linked low surface energy coating. Accordingly, the Slater composition has no mechanism for release of an antifoulant. In contrast, the antifoulant of the present composition is released by gradual hydrolysis of the paint after being coated onto the substrate.

Accordingly, for all of the above reasons, withdrawal of the anticipation rejection of Claim 51 over Slater is respectfully requested.

Claim 54 depends on Claim 51 and Applicants respectfully present that Claim 54 is not anticipated by Slater for the same reasons as those discussed above with respect to Claim 51.

**Claim Rejection Under 35 U.S.C. § 103(a) Over Slater**

Claims 53 is rejected under 35 U.S.C. § 103(a) as obvious over Slater.

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The Examiner stated that "Slater et al. teach using mixtures of crosslinking agents (column 6, lines 44-45)" and that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mixture of acyloxysilane crosslinking agents (column 6, lines 46-67) in the composition to provide crosslinking of the polymers." Office Action at 4.

Applicants respectfully traverse this rejection. As discussed above, the presently claimed compositions are hydrolysable while Slater relates to compositions that are not hydrolysable. The "conventional antifouling compositions" described by Slater include hydrolysable paint compositions which are rendered hydrolysable so that the biocide is leached out. Slater states that "[c]onventional anti-fouling paints eventually become ineffective as all their biocide is released" while "[s]ilicone rubber coatings are potentially capable of retaining their low energy surface indefinitely." Slater at col. 1, lines 25-28. Therefore, Slater teaches away from hydrolysable paint compositions.

Furthermore, the presently claimed compositions include an antifoulant while Slater teaches away from use of an antifoulant. As discussed above, Slater describes disadvantages of use of an antifoulant and the compositions of Slater are not designed to release an antifoulant. Even if one were to add an antifoulant to the compositions of Slater, such antifoulant would be locked into the cross-linked structure of Slater with no release mechanism.

Accordingly, for all of the above reasons, Slater does not suggest or motivate the composition of Claim 53 and withdrawal of the obviousness rejection of Claim 53 is respectfully requested.

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**Allowable Subject Matter**

Applicants thank the Examiner for stating that Claims 56, 57, 60, and 67 are allowable over the prior art.

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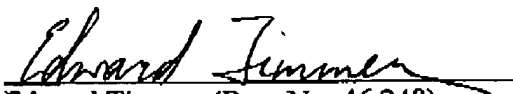
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Docket No.: SGK-028**CONCLUSION**

Applicants respectfully submit that the application is now in proper form for favorable consideration and allowance. The Examiner is invited to contact the undersigned attorney for Applicant to discuss any outstanding issues.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicants,

Date: March 23, 2011

  
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